

### **REMARKS**

This responds to the Office Action mailed on November 4, 2005, and the references cited therewith.

Claims, 11, 15, 17, 18, 20, 22, 26, 30 and 34-37 are amended, no additional claims are canceled, no claims are added; as a result, claims 11-40 remain pending in this application.

The title has been amended to be consistent with the pending claims.

The amendments made herein have been to clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims have support throughout the specification. No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

### **Election/Restriction**

Applicant previously sought clarification as to the designation of the claims into the specific class and subclasses noted by the Examiner in the Restriction Requirement mailed on March 8, 2005. (See page 2 of the Preliminary Amendment and Response to Restriction Requirement mailed on April 7, 2005 and page 8 of the Amendment and Response mailed on September 12, 2005). However, no such clarification has been forthcoming, either in the Office Action mailed on June, 13, 2005 or in the most recent Office Action mailed on November 4, 2005.

Applicant notes with appreciation, however, that claims 15-21 (Group II) are no longer indicated as withdrawn on the most recent Office Action Summary and that withdrawn claims 15-21 have now been examined, including all indicated species, i.e., claim 17, claim 18 and claim 19. It now appears that the Restriction Requirement mailed on March 8, 2005 has been withdrawn. Applicant therefore believes the proper designation for claims 15-21 is no longer "Withdrawn" but either "Original" or "Currently Amended" as is appropriate, and has made these changes accordingly. However, an affirmative statement in the next Official

Communication that the Restriction Requirement of March 8, 2005, has been withdrawn would be appreciated.

### §103 Rejection of the Claims

Claims 11-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Focke et al. (US 5,040,685) in view of Chalin et al. (US 3,873,735).

The Office Action states that Focke discloses various elements of the claims including a pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is designed to be hooked with hooking means but that Focke does not disclose the step of providing suitable markings to convey instructions to use the pull-tab opener to access the package contents without utilizing a pinch force, wherein the package is adapted to be opened easily by a person who follows the instructions conveyed by the markings. The Office Action states that Chalin discloses a similar method for providing an opening system for a container comprising the step of providing suitable markings via words to convey instructions to use the pull-tab opener to access the package contents without utilizing a pinch force, wherein the package is adapted to be opened easily by a person who follows the instructions conveyed by the markings and that it would have been obvious to modify Focke's method by having the step of providing suitable markings to convey instructions to use the pull tab opener to access package contents as suggested by Chalin, in order to make it easy and simple opening and handling such containers.

Applicant respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Furthermore, claims 12-14, 16-35 and 37-40 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Focke discusses a package which can be initially opened by grasping a closing flap 23 and lifting it as a part of the folding flap 18 into an upright position (FIG. 3) or back against the rear wall (col. 3, lines 15-18) to expose an extraction opening 30. When the pack is opened via the adhesive tape 35, the foil piece 41 is severed out of the folding flap 17 when the folding flap 18 is lifted, thus forming a recess 39 (col. 4, lines 20-24) in a sidewall. The recess 39 provides an additional access point which "serves to improve or enlarge the extraction opening [30]" (col. 3, lines 67-68).

In contrast, claim 11, as amended, recites a method of providing an enhanced opening system for a sealed container comprising providing a bag having lines of weakness and a pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is designed to be hooked with hooking means; and providing suitable markings to convey instructions to use the pull-tab opener to access contents within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened easily with the pull-tab opener by a person who follows the instructions conveyed by the markings. Also in contrast, claim 15, as amended, recites, a method of providing an enhanced product removal system for a sealed container comprising providing a sealed container having lines of weakness; providing at least one product disposed within the sealed container; and providing a pull-tab opener secured to the sealed container proximate to the lines of weakness wherein the pull-tab opener has a pull-tab opening configured to allow a user to hook the pull-tab opener through the pull-tab opening and apply sufficient force without utilizing a pinch force, to tear the sealed container at the lines of weakness creating an opening, further wherein the product is oriented proximate to the opening to facilitate easy removal of the product. Further in contrast, claim 36, as amended, recites a method of providing an enhanced opening system for a sealed container comprising providing a bag having lines of weakness and a pull-tab opener for opening the sealed container, the pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab

opening integral therewith, wherein the pull-tab opening is designed to be hooked with hooking means.

Chalin does not overcome the deficiencies of the primary reference. Chalin discusses a food package for heating and venting food contents contained within. The package has a lift tab 828 which serves as a means of grasping. The lift tab is a part of the package and is not separately secured to the bag. The lift tab has no opening.

Clearly, the product in the primary reference and each of the products in the secondary references are fundamentally different from each other and such critical differences must be recognized. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

Additionally, there is simply no suggestion in Focke *as to the desirability* of conveying instructions to use the pull-tab opener to access the package contents without utilizing a pinch force as suggested in the Office Action. Additionally, the lift tab of Chalin requires use of a pinch force, so does not teach or suggest such instructions: "Lift tab 828 serves as a means of *grasping* the appropriate part of cover 804 when a vent is to be formed as shown in FIG. 27. (col. 17, lines 8-10) (emphasis added). Even assuming that the instructions of Chalin were as described in the Office Action, i.e., "to use the pull-tab opener to access the package contents without utilizing a pinch force," such instructions would make the package of Focke inoperable because it is only *with* the use of a pinch force that the package of Focke can be opened. Therefore there is no reasonable expectation of success even if the references were combined.

Regarding claim 28, the Examiner states on page 3 of the Office Action that "Focke discloses that the hooking means comprises one to three fingers or [an] object, the object having a maximum diameter not greater than about eight cm, (Figs. 1 and 3, via the 39 and 41)." Applicant respectfully traverses this statement and further clarifies that Focke relies on "grasping means" to open the package, not "hooking means." For example, "When opening the pack, the adhesive strip 35 is *grasped* at the "*grip* end 38." (col. 3, lines 58-59) (emphasis added). Foil piece 41, referred to by the Office Action, is tightly connected to the bottom face of the closing flap 23. (col. 4, lines 13-15). There is no teaching or suggestion that the foil piece 41 can be hooked. The recess 39, also referred to by the Office Action, again is present to "improve or

enlarge the extraction opening [30]" (col. 3, lines 67-68). Again, there is no teaching or suggestion that the recess is designed to be hooked by any means. The recess 39 does, however, facilitate, "the grasping of a tissue for extraction." (col. 4, lines 5-6). Additionally, the only reference to "fingers" Applicant can find in Focke is with respect to the number of fingers it takes to grasp the contents, i.e., "the foremost tissue can be comfortably *grasped* with two fingers (col. 2, lines 67-68) (emphasis added).

There is further absolutely no indication in either of the references of any appreciation of the problem being solved by Applicant's invention. By providing the enhanced opening system recited herein, a user can now, for the first time use a pull-tab opener having a pull-tab opening integral therewith which is designed to be hooked with hooking means and can open a sealed container *without utilizing a pinch force*. This is not possible with the pull tabs in either of the references cited. When a person, having the references before him and not cognizant of Applicant's disclosure, would not be informed that a problem (solved by Applicant's claimed invention) ever existed, such references (which never recognized the problem) *could not have suggested its solution*. Combining references in this manner is improper. In re Shaffer, 229 F.2d 476, 108 USPQ 326, 329 (CCPA 1956). Focusing on the obviousness of substitutions and differences instead of on the invention as a whole is a legally improper way to simplify the difficult determination of obviousness. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81, 93 (Fed. Cir.1986).

An additional requirement of the *prima facie* case is that the *references must teach or suggest all the claim limitations*. As noted above, the references fail to teach or suggest various elements of the claims, including, but not limited to, providing a pull-tab opener having a pull-tab opening *integral therewith*, wherein the pull-tab opening is designed to be hooked with hooking means; and providing suitable markings to convey instructions to use the pull-tab opener to access contents within the sealed container without utilizing a pinch force, wherein the sealed container is adapted to be opened easily with the pull-tab opener.

Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. Applicant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03,

Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Applicant respectfully submits that claims 11-40 are patentably distinct from the cited references, either alone or in combination. Claims 11-40, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC 103(a).

Reconsideration and withdrawal of this rejection is respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date February 2, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2nd day of February, 2006.

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